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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,692	03/28/2001	Hirokazu Tanaka	ISH-001-USA-CIP	9945

7590 03/24/2004

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EXAMINER
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WELLS, LAUREN Q

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

### Application No.

09/818,692

### Applicant(s)

TANAKA ET AL.

### Examiner

Lauren Q Wells

### Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Claims 1-17 and 23 are pending.

***Priority***

Applicant argues, "Certified copies of the priority documents, as well as English translations thereof, have been previously submitted in this case. It is believed that the submission of these documents perfects priority, i.e., entitle the present inventors to claim an effective filing date of August 16, 1990". This argument is not persuasive. As stated in the previous Office Action, the description of SiO<sub>2</sub> as non-porous in the instant Application was not recited in either the foreign priority document or the domestic priority documents. Thus, the effective and actual filing date for the instant Application is 3/23/01.

***103 Rejection Maintained***

The rejection of claims 1-17 and 23 under 35 U.S.C. 103(a) as being unpatentable over Seo et al. (6,030,627) in view of Golz-Berner et al. (6,309,627) is MAINTAINED for the reasons set forth in the Office Action mailed 7/16/03, and those found below.

It is respectfully pointed out that Applicant has argued against the references individually and that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues, "the coating layer of the present invention comprises particles which have a spherical form deposited on a base having a flat grain size. . .Accordingly, the flaky, fine base substance, such as mica, has the unexpected and superior property of homogeneous light distribution". This argument is not persuasive. First, this argument is not commensurate in

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scope with the instant claims, which do not recite a flat grain size or homogeneous light distribution. Second, it is respectfully pointed out that Seo et al. teach a coating layer comprising particles which have a spherical form deposited on a base. Third, it is respectfully pointed out that Applicant has not provided unexpected data comparing the instant invention with that of the closest prior art. Thus, arguing unexpected/superior properties of the instant invention, is not persuasive.

Applicant argues that the declaration filed 5/22/96 in the parent application demonstrates unexpected results. However, the Examiner is unable to locate such a declaration. Additionally, the primary reference in which the Examiner is relying was published in 2000. Thus, it is not clear how a declaration in 1996 can provide comparative data of the instant invention with that of the prior art, especially since the recitation of non-porous silica was not added to the instant invention until 3/23/01, the instant Application. The Examiner respectfully directs Applicant to the guidelines for showing unexpected results. It is applicant's burden to demonstrate unexpected results over the closest prior art. See MPEP 716.02, also 716.02 (a) - (g). Furthermore, the unexpected results should be demonstrated with evidence that the differences in results are in fact unexpected and unobvious and of both statistical and practical significance. *Ex parte Gelles*, 22 USPQ2d 1318, 1319 (Bd. Pat. App. & Inter. 1992). Moreover, evidence as to any unexpected benefits must be "clear and convincing" *In re Lohr*, 137 USPQ 548 (CCPA 1963), and be of a scope reasonably commensurate with the scope of the subject matter claimed, *In re Linder*, 173 USPQ 356 (CCPA 1972).

Regarding Seo, Applicant argues, "the spherical silica disclosed therein is NOT the coating layer of the base, but rather the inorganic cosmetic pigment". This argument is not

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persuasive. It is respectfully pointed out that Seo et al. teach that silica can be the inorganic cosmetic pigment and that SiO<sub>2</sub> is the coating layer, wherein silica and mica are taught as interchangeable pigments (bases). The reference does teach SiO<sub>2</sub> as the coating layer. The Examiner is therefore confused as to why Applicant is stating that the reference does not teach it as the coating layer. See specifically Col. 4, line 54-Col. 7, line 2 and Col. 17, claim 4.

Applicant argues, "it should be noted that Col. 1, lines 40-51, of the cited reference make no mention whatsoever of the prevention of glossiness of the composition on the skin. . . would actually achieve the opposite effect of the present invention, i.e., would INCREASE glossiness". This argument is not persuasive. It is respectfully pointed out that Applicant is arguing the properties of his composition against properties of the reference. Such an argument is not commensurate in scope with the instant claims. Additionally, Applicant is arguing against the references individually, when the rejection was made over a combination of references.

It is respectfully pointed out that the combined references teach the same product made in the same manner, as that of the instant claims. It is again respectfully pointed out that the rejection was made over a combination of references. Thus, arguing that one reference does not meet all the limitations of the instant claims is not persuasive, as it is the combination of the references that teaches all of the limitations.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is 571-272-0634. The examiner can normally be reached on M&R (5:30-4).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

lqw



**SREENI PADMANABHAN**  
**SUPERVISORY PATENT EXAMINER**